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EXAMINER

DINH, KHANH Q

ART UNIT PAPER NUMBER

2151

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/772,950 | <b>Applicant(s)</b><br>SHAKED ET AL. |  |
|                              | <b>Examiner</b><br>Khanh Dinh        | <b>Art Unit</b><br>2151              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This is in response to the Amendment filed on 8/4/2005. New claims 27-28 and claims 1-26 are presented for examination.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (hereafter Li), US pat. No.6,012,088.

As to claim 1, Li discloses a method for automatically acquiring a persistent identity of a user requesting service from a service provider, said method comprising:

sending an identification request including persistent (user IP network address) and transient identity information (registration ID), by the service provider to a network

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access provider (NAP) (contacting to ISP Internet Service Provider to locate data information for users and to generate a configuration file for future user by the customer, see figs.1, 4, abstract, col.4 line 66 to col.5 line 23, col.10 lines 26-65 and col.11 line 26 to col.12 line 27), said NAP comprising a NAP identification (ID) module and an access system in communication with said NAP identification module (checking for valid user ID), extracting persistent identity information associated with said user, verifying the persistent identity information of said user and forwarding said information associated with said user to said service provider, by said NPA ID module; and forwarding said persistent and transient identity information to the service provider (see fig.11A, 11B, col.12 line 38 to col.13 line 48).

As to claim 2, Li discloses sending an identification (ID) request comprises sending the ID request via at least one identification switch (see fig.5, col.10 lines 26-65 and col.7 lines 11-57).

As to claim 3, Li discloses verifying whether the transient identity information of the user is included in the ID request; and if the transient identity information (registration ID) of the user is not included, extracting the transient identity information when the user connects to the NAP (allowing automatic configuration to an access internet device, see fig.7, col.10 lines 26-65, col.13 lines 11-58 and col.14 lines 13-49).

As to claim 4, Li discloses retrieving data from a group of databases including an online

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session database (420 fig.8) in communication with said NAP and a user information database in communication with said NAP (see fig.8, col.13 line 53 to col.14 line 49).

As to claim 5, Li discloses detecting a request from the user of a specific URL, said specific URL being identifiable by a plug-in installed in the proxy server of said NAP; and said plug-in reporting the transient identity information (registration ID) of the user (processing customer's URL request, see fig.8, col.13 line 53 to col.14 line 49).

As to claim 6, Li discloses detecting a request from the user of a specific URL, said specific URL being identifiable by a network sniffer installed between the user and the proxy server of said NAP and said sniffer reporting the real network address of the user, by said sniffer (determining level of service desired by customer, see fig.8, col.13 line 53 to col.14 line 49 and col.9 lines 11-63).

As to claim 7, Li discloses instructing the user to connect to the address extraction module of said NAP via an alternative service or port not associated with the proxy server, opening a direct connection to said address extraction module and by automatically configuring the proxy settings (see fig.6, col.8 line 5 to col.9 line 25 and col.10 lines 6-65).

As to claims 8 and 9, Li discloses reporting said persistent and transient identity information (registration ID) associated with said user to said service provider and

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verifying information items provided in the identification request; and forwards a match score describing the similarity between the information associated with said user and the information items provided in the identification request (see figs.6, 7, col.9 lines 11-63 and col.10 line 17 to col.11 line 16).

As to claims 10 and 11, Li discloses sending a virtual ID for said user to said service provider and sending information associated with said user in a previous request to said service provider (using automatic configuration, see fig.8, col.11 line 17 to col.12 line 65 and col.13 lines 11-48).

As to claim 12, Li discloses determining the identity of the NAP servicing said user, forwarding said identification request to said NAP identification module, determining whether said identification request includes the of said user; and if said identification request does not include the transient identity information of said user, extracting the transient identity information when the user connects to the NAP (using the configuration records to generate configuration records for users, see fig.10, col.9 lines 11-63 and col.13 line 60 to col.14 line 65).

As to claim 13, Li discloses maintaining a look-up table of transient identity information associated with a plurality of NAPs and determining the identity of the NAP by reference to said look-up table (routing table) (see fig.5, col.7 lines 12-57 and col.8 lines 14-57).

As to claims 14 and 15, Li discloses said look-up table is updated manually whenever transient identity information assignments change and is updated automatically from said NAP identification module based on information reported from said access system (using automatic configuration, see col.7 lines 12-57 and col.9 line 26 to col.10 line 43).

As to claim 16, Li discloses said look-up table is constructed from existing transient identity information assignment databases (see fig.5, col.7 lines 12-57 and col.8 lines 14-57).

As to claim 17, Li discloses a method for automatically identifying a user requesting service from a service provider, said method comprising:

said service provider determining the veracity of the transient identity information reported by the user (contacting to Internet Service Provider ISP to locate data information for users, see figs.1, 4, abstract, col.4 line 66 to col.5 line 23 and col.11 line 26 to col.12 line 27); if said transient identity information is determined to be trusted, said service provider including said transient identity information in an identification request and sending said identification request to a network access provider (NAP), said NAP comprising a NAP identification module; and providing service in accordance with said service request (checking for valid user ids according to requests, see fig.11A, 11B, col.12 line 38 to col.13 line 48);

or if the transient identity data is determined not to be trusted (unsuccessful configuration), said service provider sending an identification request to a network access provider (NAP) for providing persistent identity data of said user and forwarding said persistent identity data associated with said user to said service provider (see col.13 line 49 to col.14 line 49).

Claims 18, 19 are rejected for the same reasons set forth in claims 2, 12 respectively.

As to claim 20, Li discloses configuring at least one network appliance to route specific requests to a specified NAP; and the NAP identification module associated with said specified NAP identifying said user (see fig.8, col.11 line 17 to col.12 line 65 and col.13 lines 11-48).

As to claim 21, Li discloses one of a group including an HTTP proxy and a WAP Gateway (using a proxy server, see fig.6, col.8 line 5 to col.9 line 25 and col.10 lines 6-65).

As to claim 22, Li discloses a system for automatically acquiring the identity of the user (92 fig.4) of an anonymous network, said system comprising:

a service provider (ISP 14 fig.4) in communication with said user and at least one network access provider (NAP) (100 fig.4) in communication with said service provider and said user (contacting to ISP to locate data information for users, see fig.1, abstract,



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col.4 line 66 to col.5 line 23 and col.11 line 26 to col.12 line 27); said at least one NAP comprising: a NAP identification module to provide persistent identity data; a controller; an address extractor in communication with said controller, to enable extraction of transaction of transient identity data; and an access system in communication with said address extractor (see fig.5, col.10 lines 26-65 and col.7 line 12 to col.8 line 50).

As to claim 23, Li discloses at least one online session database (420 fig.8) in communication with said controller and said access system, said at least one online session database containing at least information associating said user with the user's transient identity information (see col.10 lines 26-65 and col.11 line 17 to col.12 line 37).

Claim 24 is rejected for the same reasons set forth in claim 2.

As to claim 25, Li discloses at least one user information database, in communication with said controller (using the configuration records to process user requests, see fig.10, col.9 lines 11-63 and col.13 line 60 to col.14 line 65).

As to claim 26, Li discloses at least one of a group of databases containing data including persistent personal data related to said user (using automatic configuration process, see fig.8 line 17 to col.12 line 65 and 15 lines 7-54).

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As to claim 27, Li discloses at least one of a group of consisting of: billing information, information about past user logins, and a reverse telephone directory (see fig.10, col.9 lines 11-63 and col.13 line 60 to col.14 line 65).

As to claim 28, Li discloses said identification request including data from one or more persistent elements not typically available online (see fig.7, col.9 line 26 to col.11 line 65 and col.16 lines 5-60).

### ***Response to Arguments***

4. Applicant's arguments filed On 8/4/2005 have been fully considered but they are not persuasive.

\* Applicant asserts that the cited reference does not disclose the newly amended limitations "persistent and transient identity information".

*Examiner respectfully disagrees. Examiner point out that Li still discloses identification request including persistent (user IP network address) and transient identity information (registration ID), by the service provider to a network access provider (NAP) (contacting to ISP Internet Service Provider to locate data information for users and to generate a configuration file for future user by the customer, see figs.1, 4, abstract, col.4 line 66 to col.5 line 23, col.10 lines 26-65) as rejected above.*

*As a result, cited prior art does disclose a method for automatically acquiring a persistent identity of a user requesting service from a service provider, as broadly*

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*claimed by the Applicants. Applicants clearly have still failed to identify specific claim limitations that would define a clearly patentable distinction over prior art.*

### **Conclusion**

5. Claims 1-28 are rejected.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (571) 272-3939. The fax phone number for this group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khanh Dinh  
Primary Examiner  
Art Unit 2151  
11/22/2005